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IN THE

Supreme Court of the United States

OCTOBER TERM, 1962

NO. 322

ALEXANDER T. SPERRY, Petitioner,

v.

STATE OF FLORIDA, ex rel., THE FLORIDA BAR,
Respondent.

On Writ of Certiorari to the Supreme Court of Florida

BRIEF OF AMERICAN PATENT LAW ASSOCIATION AS AMICUS CURIAE

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BRIEF OF AMERICAN PATENT LAW ASSOCIATION AS AMICUS CURIAE

This brief is filed by the American Patent Law Association as amicus curiae pursuant to the written consent of the petitioner and respondent which is on file in the Clerk's Office.

I.

INTEREST OF AMICUS CURIAE

The American Patent Law Association is an association of over two thousand attorneys who are interested in the branches of law relating to patents, trademarks, copyrights and unfair competition. The large majority of the members of the association specialize in

Interest of Amicus Curiae.

the practice of patent law, including the representation of clients before the Patent Office and other administrative tribunals, the representation of clients in the Courts, both state and federal, and the preparation of opinions, contracts and other office matters relating to patents. The members of the Association are located in all parts of the United States.

The objects of the association are succinctly set forth in Article II of the Articles of Association. That Article reads in part as follows:

> "The objects of this Association shall be to maintain a high standard of professional ethics . . . to protect the administration of such [patent, trademark, copyright and unfair competition] laws against practices and practitioners tending to impose upon the public or otherwise to bring the patent, trademark or copyright systems into disrepute; . . . ."

The association is vitally interested in the outcome of the instant case, since it is directly concerned with the regulation of the practice of patent law. The association has been keenly aware of the questions raised by the present case for several years. In 1958, the association adopted a "Statement of Principles" intended as a general guide to the authorized practice of law relating to patents and trademarks. That Statement as amended in June 1959 reads as follows:

> "1. The right to practice law within a state is a personal franchise granted by the state to those who have complied with its rules and regulations pertaining thereto.
>
> "2. Each state has the right to prescribe its own rules and regulations for admission to practice law, and it alone has the power to control such practice within its borders.

Interest of Amicus Curiae.

"3. What constitutes the practice of law in any state is determined by the laws and decisions of the courts of that state.

"4. A franchise to practice law granted by one state does not extend beyond its own borders.

"5. There is, absent admission to practice law in a state, no such thing as admission to practice Federal Law or Foreign Law but (a) a lawyer permitted to practice before the United States Patent Office may prepare and prosecute applications and perform such other acts within the Patent Office as the Patent Office permits if the laws, rules, regulations or customs in the state where the lawyer maintains his office permit the same, and (b) a lawyer admitted to practice before a particular Federal Court may appear before such Court to the extent that such Court permits.

"6. A person admitted to practice law in any state may render legal services, or give legal advice, with respect to the law of any other state, or of the United States, or of any foreign country, as long as it is a part of his practice within the state where he is admitted.

"7. Any person who practices, or assumes to practice law within a state, without having been duly admitted or without otherwise complying with the recognized laws, rules or customs in that state is a layman engaged in the unauthorized practice of the law."

The petitioner herein is directly challenging the substance of these Principles. The petitioner directly raises the question as to the power of the state versus the power of the federal government to authorize and control the practice of law in the state by those having an office in the state who appear before federal agencies and otherwise advise and counsel the public in the area of law of interest to the agency.

II.

SUMMARY OF ARGUMENT

1. The right to practice law within a state is a personal franchise granted by the state. What constitutes the practice of law in any state is determined by the laws and decisions of the courts of that state. Each state has the sole right to prescribe rules and regulations for admission to practice law and it alone has the power to control such practice within its border. The Florida Supreme Court has decided that the services performed by the petitioner in Florida constitute the practice of law in Florida. That decision is not unreasonable or arbitrary and is not challenged by petitioner.

2. The Constitution of the United States does not empower Congress or its delegatee to authorize the practice of law in the several states. The judicial power of the United States, was vested in the United States Supreme Court, and, assuming *arguendo,* that the federal government has any power to authorize the practice of law in the several states, that power is vested in the judicial branch of the government. No such power has been assumed or exercised by the judicial branch of the federal government.

3. Neither Congress nor its delegatee, the Commissioner of Patents, has attempted to authorize the practice of law in the several states. Congress has merely empowered the Commissioner of Patents to regulate the admission and conduct of persons appearing before the Patent Office so that the Patent Office may properly perform its functions. This power is not incon-

sistent with the power of the several states to authorize and control the practice of law within their own borders.

4. The State of Florida has a legitimate interest in the control of the practice of the law pertaining to patents and trademarks in Florida. Many questions of state law are raised in the normal course of patent and trademark practice. The Constitution wisely leaves the control of the practice of all phases of the law to the several states.

III.

ARGUMENT

A. The Practice of Law Is Controlled by the States.

The right to practice law within a state is a personal franchise granted by the state. The state alone has the right to define, control and regulate the practice of law within its borders. In *Bradwell v. State of Illinois* (1872) 16 Wall. (83 U.S.) 130, this Court stated (p. 139):

> ". . . the right to control and regulate the granting of license to practice law in the courts of a State is one of those powers which are not transferred for its protection to the Federal government, and its exercise is in no manner governed or controlled by citizenship of the United States in the party seeking such license."

This elementary truth has been reaffirmed frequently by this Court. *In re Lockwood* (1894) 154 U.S. 116, this Court denied an application for leave to file a petition for a *mandamus* requiring the Supreme Court of Appeals of Virginia to admit Mrs. Lockwood to practice law in Virginia, since the right to control and regulate the practice of law was the right of the several states. See also *Selling et al. v. Radford* (1917) 243 U.S. 46, 50 and *Yeiser v. Dysart et al.* (1925) 267 U.S. 540, 541. *In re Summers* (1945) 325 U.S. 561, 571, this Court stated:

> "The responsibility for choice as to the personnel of its bar rests with Illinois. Only a decision which violated a federal right secured by the Fourteenth Amendment would authorize our intervention."

In *Konigsberg v. State Bar of California et al.,* (1957) 353 U.S. 252, 273, the Court again stated:

> "We recognize the importance of leaving States free to select their own bars, but it is equally important that the State not exercise this power in an arbitrary or discriminatory manner nor in such way as to impinge on the freedom of political expression or association."

The Supreme Court of Florida, in the exercise of these powers, has held that the acts and practices of the petitioner in Florida constitute the practice of law *in Florida*. A mere listing of a few of the acts of the petitioner demonstrates that this decision is not arbitrary. For example, the petitioner (1) gives legal opinions on patentability of inventions, including whether there is patentable subject matter (35 U.S.C. 101), whether there is a statutory bar (35 U.S.C. 102), and whether there is patentable invention (35 U.S.C. 103); the petitioner (2) prepares and presents arguments and briefs on questions of law; he (3) prepares affidavits and assignments; and he (4) takes testimony in *inter partes* proceedings. The foregoing is not a comprehensive list of the activities of petitioner which the Florida Supreme Court considered the practice of law, but it is sufficient to demonstrate that the decision was not arbitrary.

B. Congress Cannot Authorize the Practice of Law in the State of Florida.

The petitioner does not challenge the right of the State of Florida to regulate the practice of law in Florida generally. (Petitioner's Brief, p. 11) Nor does the petitioner challenge the decision of the Florida Supreme Court that his conduct constitutes the practice of law.* Instead, the petitioner argues that under the United States Constitution and Acts of Congress, he has the right to continue the acts proscribed by the Florida Supreme Court, notwithstanding the fact that the acts constitute the practice of law. This argument is contrary to the authorities cited above (e.g. *Konigsberg v. State Bar of California et al., supra,* recognizing "the importance of leaving the States free to select their own bars") and is not supported by the Constitution (see *Bradwell v. State of Illinois, supra,* holding that the right to control the practice of law was not transferred to the federal government).

The Constitution does not empower Congress to authorize the practice of law in the several states. Indeed, the Constitution, in effect, prohibits Congress from enacting legislation which would authorize the practice of law in the several states.

The Constitution expressly vests the judicial power of the United States "in one Supreme Court, and in such

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* The Brief of American Association of Registered Patent Attorneys and Agents, Amicus Curiae (pp. 8-12) challenges this holding of the Florida Supreme Court. However, the question is not properly before this Court. Rule 23 (1) (c), *Knetsch v. United States* (1960) 364 U.S. 361, 370.

inferior Courts as Congress may from time to time ordain and establish." Art. III, Sec. 1. The judicial power of a government includes the power to authorize, control and regulate the practice of law. Thus, assuming *arguendo,* that the federal government has any power to authorize the practice of law in the several states that power is vested by the Constitution solely in the judicial branch of the federal government. Thus, under the Constitution, Congress does not have the power to authorize the practice of law.

This Court, the lower federal Courts, and many state Courts have recognized and held that where the Constitution vests the judicial power of the government in the Courts, only the Courts can authorize, control and regulate the practice of law. In *Ex parte Secombe* (1856) 19 How. (60 U.S.) 9, 13, this Court stated:

> "And it has been well settled, by the rules and practice of common-law courts, that *it rests exclusively with the court to determine who is qualified to become one of its officers, as an attorney and counsellor,* and for what cause he ought to be removed. The power, however, is not an arbitrary and despotic one, to be exercised at the pleasure of the court, or from passion, prejudice, or personal hostility; but it is the duty of the court to exercise and regulate it by a sound and just judicial discretion, whereby the rights and independence of the bar may be as scrupulously guarded and maintained by the court, as the rights and dignity of the court itself."*

In *Laughlin v. Clephane et al.,* (D.C. D.C., 1947) 77 F. Supp. 103, 105, the Court stated:

> "As attorneys are officers of the court, *the power to admit applicants to practice law is judicial and not legislative and is vested in the courts only.*

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* Emphasis ours throughout this brief.

"It is the duty of the court to exercise and regulate the admission of applicants to the bar by sound and just judicial discretion. In re Secombe, 19 How. 9, 15 L. Ed. 565; * * *"

In *Emmons v. Smitt et al.,* (D.C. E.D. Mich. 1944) 58 F. Supp. 869, affd. 149 F. 2d 869, the Court stated:

"The right to control and regulate the granting of a license to practice law in the State of Michigan belongs to the State and in Michigan is governed entirely by the Supreme Court. Bradwell v. Illinois; Selling v. Redford, supra, and other cases cited herein."

In Re Opinion of the Justices (1935) 289 Mass. 607, 194 N.E. 313, 316, the Supreme Court of Massachusetts rendered an advisory opinion to the State Senate on the question as to whether it was "constitutionally competent" for the General Court or Legislature to enact legislation admitting or forbidding corporations or others to practice law in Massachusetts other than in its courts. In answering this question in the negative, the Court, among other things, said:

"It is inherent in the judicial department of government under the Constitution to control the practice of the law, the admission to the Bar of persons found qualified to act as attorneys at law and the removal from that position of those once admitted and found to be unfaithful to their trust. While the judicial department cannot be circumscribed or restricted in the performance of these duties, appropriate and essential assistance in discharging them may be afforded by the enactment of statutes. As the questions are framed and as a general proposition, valid permission to practice law cannot be given by the General Court except subject to the requirements for admission to the bar established by the judicial department. Opinion of the Justices, 279 Mass. 607, 180 N.E. 725, 81 A.L.R. 1059."

In another leading case, *People v. People's Stock Yards State Bank,* (1931), 344 Ill. 462, 176 N.E. 901, 905, 906, a bank, which was practicing law in the real estate and other fields, was found guilty of contempt of Court for engaging in the practice of law and enjoined from continuing to do so. The Court, among other things, made the following cogent statement, which has been frequently quoted or referred to:

> "Under the Constitution of this state, the judicial power is vested solely in the Courts. Const. art. 6 para. 1, and article 3; *Missouri River Telegraph Co. v. First Nat. Bank,* 74 Ill. 217; *in re Day,* 181 Ill. 73, 54 N.E. 646, 50 L.R.A. 519. Included in this grant are all powers necessary for complete performance of the judicial functions. *State of Illinois v. Illinois Central Railroad Co.,* 246 Ill. 188, 92 N.E. 814. Although the Constitution does not expressly confer upon this court power and jurisdiction with respect to the admission of attorneys to practice law, such power and jurisdiction are necessarily implied and are inherent in this court. *In re Day, supra.* As a part of such inherent power, this court may not only determine the educational and moral qualifications of applicants for admission to the bar, but may also discipline or disbar attorneys for misconduct. *People v. Chamberlain,* 242 Ill. 260, 89 N.E. 994; *People v. Czarnecki,* 268 Ill. 278, 109 N.E. 14. Attorneys are officers of this court, and their conduct as such is subject to supervision by it. They are, in effect, a part of the judicial system of the state. *In re Day, supra. People v. Czarnecki, supra; Ex parte Secombe,* 19 How. 9, 15 L. Ed. 565; *Ex parte Wall,* 107 U.S. 265, 2 S. Ct. 569, 27 L. Ed. 552. The power to prescribe the qualifications which will entitle an applicant to be admitted to the bar is judicial, as is also the power to discipline or disbar attorneys for professional misconduct either in court proceedings or their relations with clients outside of court.

> "Having inherent and plenary power and original jurisdiction to decide who shall be admitted to practice as attorneys in this state, this court also has all the power and jurisdiction necessary to protect and enforce its rules and decisions in that respect. Having power to determine who shall and who shall not practice law in this state, and to license those who may act as attorneys and forbid others who do not measure up to the standards or come within the provisions of its rules, it necessarily follows that this court has the power to enforce its rules and decisions against offenders, even though they have never been licensed by this court. Of what avail is the power to license in the absence of power to prevent one not licensed from practicing as an attorney? In the absence of power to control or punish unauthorized persons who presume to practice as attorneys and officers of this court the power to control admissions to the bar would be nugatory. And so it has been held that the court, which alone has authority to license attorneys, has as a necessary corollary ample implied power to protect this function by punishing unauthorized persons for usurping the privilege of acting as attorneys."

In *Bump v. District Court of Polk County,* (1924), 232 Iowa 623, 5 N.W. 2d 914, a non-lawyer was found guilty of the unauthorized practice of law. The Court, among other things, said:

> "Under the Constitution of Iowa, vesting judicial power exclusively in the courts, Article V, Section 1, and Section 12542 of the Code, the courts of this state are vested with complete authority to punish by contempt proceedings unlawful practice. See, also *Johnson v. Purcell,* supra, and cases cited therein."

The foregoing cases show clearly the unanimity of opinion that only the branch of the government vested with the judicial power of the government can authorize

the practice of law. The legislative branch of the government does not have the power to authorize the practice of law.

The petitioner suggests that the Congress derives some power to authorize the practice of law relating to patents in the several states from Article I, Section 8, clause 8 of the Constitution, which reads as follows:

> "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries; . . ."

The argument that since Congress can grant patents it can also authorize the practice of law relating to patents is fallacious. It is neither necessary nor proper for Congress to authorize the practice of law in the several states in order to provide for the issuance of patents. If the petitioner's argument was sound, it would follow that the States' power to control the practice of law and the power of the judicial branch of the government to control the practice of law would be substantially limited. If Congress can authorize the practice of law with respect of each branch of law in which it has legislative power, the control over the practice of law exercised by the states and, specifically, by the judicial branch of the government, would be so diluted as to be practically nonexistent, except as to actual court appearances.

The Constitution does not empower the Congress to authorize the practice of law in the several states. This power is retained by the several states. If the federal government has any power to authorize this practice of law in the several states [See *Ginsburg v. Kovrak*, (1958) 392 Pa. 143, appeal dismissed for want of a substantial federal question (1958) 358 U.S. 52] that power belongs

to the judicial branch of the government. Clearly, Congress does not have the power under the Constitution to authorize the acts of petitioner *in the State of Florida.*

C. Neither Congress Nor the Commissioner of Patents Has Attempted to Authorize the Practice of Law in the State of Florida.

The foregoing demonstrates that Congress does not have power under the Constitution to authorize acts in the several states which constitute the practice of law in that state. Petitioner's argument that Congress and its delegatee, the Commissioner of Patents, have authorized the acts enjoined by the Florida Supreme Court is fallacious for a second reason. Neither Congress nor the Commissioner of Patents has attempted to authorize the practice of law in the several states. The Commissioner of Patents, pursuant to authority granted by Congress, has regulated practice *before the Patent Office* to protect the Patent Office in the performance of its duties. This regulation does not authorize the practice of law in the several states.

Pursuant to the power given it by the Constitution of the United States (Art. I, Sec. 8, Cl. 8), Congress enacted the Patent Act of 1952 (35 U.S.C. 1—293). That Act provides for the establishment of a Patent Office and for officers and employees of the Patent Office, including a Commissioner of Patents, whose duties are specified (35 U.S.C. 1, 3, and 6). The Patent Act of 1952 expressly authorizes the Commissioner to prescribe regulations covering the recognition and conduct of persons representing applicants for patents before the Patent Office. The statute (35 U.S.C. 31) provides:

> "The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties *before the Patent Office,* and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office."

This section of the patent laws provides that the regulations shall cover representation "before the Patent Office" and nowhere else. There is nothing in the section authorizing the Commissioner of Patents to regulate practice in any other jurisdiction; specifically it does not authorize the Commissioner of Patents to regulate any phase of the practice of law in the several states.

Pursuant to the congressional authorization, the Commissioner has issued a number of rules governing those who are authorized to practice before the Patent Office in patent cases (37 C.F.R. 1.341-1.348). These rules provide for the registration of attorneys and agents. They, however, expressly recognize that registration in the Patent Office entitles persons to practice only before the Patent Office. Thus, Rule 341 (37 C.F.R. 1.341) provides:

> "Registration in the Patent Office under the provisions of these rules shall only entitle the person registered to practice before the Patent Office."

The power given to the Commissioner to regulate the admission and conduct of persons representing applicants before the Patent Office was designed for the

protection of the Patent Office. This is brought out in *Kingsland v. Dorsey* (1949), 338 U.S. 318, in which the Supreme Court upheld the action of the Commissioner of Patents in disbarring an attorney from practice before the Patent Office because of concealment from the Patent Office of a material fact during the prosecution of an application. In sustaining the Commissioner, the Court said (p. 319-320):

> "The statute under which the Commissioner acted represents congressional policy in an important field. It relates to the character and conduct of 'persons, agents or attorneys' who participate in proceedings to obtain patents. We agree with the following statement made by the Patent Office Committee on Enrollment and Disbarment that considered this case: 'By reason of the nature of an application for patent, *the relationship of attorneys to the Patent Office* requires the highest degree of candor and good faith. In its relation to applicants, the Office . . . must rely upon their integrity and deal with them in a spirit of trust and confidence. . . .' It was the Commissioner, not the courts, that Congress made primarily responsible for protecting the public from the evil consequences that might result if practitioners should betray their high trust."

Thus, Congress has authorized the Commissioner of Patents to regulate the admission and conduct of practitioners before the Patent Office in order that the Patent Office may properly perform its functions in the best interests of the public. Congress has been concerned solely with the operation of the Patent Office and not the practice of law, and the Commissioner of Patents has not attempted to go beyond the confines of the Patent Office. Nothing in the powers granted to the Commissioner of Patents to regulate practice in the Patent Of-

fice is inconsistent with the established right of the several states to control the practice of law within their borders.

D. The State of Florida Has a Legitimate Interest in the Practice of Patent Law Within the State of Florida.

At the outset, we point out that the Supreme Court of Florida has expressly disclaimed its right or the right of the State of Florida to control practice in the Patent Office or the admission of persons to practice in the Patent Office. It held only that the Supreme Court of Florida had the right to control the practice of law in Florida. Thus, the Court said (R. 65):

> "As above stated, we have no argument with the power of such agencies to determine who shall practice before them, but we do not agree that their licensing of a non-lawyer is in anywise to be taken as proof that the work done before them is not the practice of law or that one licensed by them has the right by virtue of said license to hold himself out as qualified to do those things in this state."

In so holding, it followed the principle of the decision of the Supreme Court of Pennsylvania in *Ginsburg v. Kovrak* (1958), 392 Pa. 143, 130 A.2d 889, appeal dismissed (1958) 358 U.S. 52, in which an attorney admitted to practice in the United States Supreme Court, the District Court and the Circuit Court of Appeals for the District of Columbia, and the Federal District Court for the Eastern District of Pennsylvania, but who was not admitted in the courts of the state, was enjoined from practicing law in Philadelphia County, Pennsylvania. The attorney claimed to limit his practice to federal tax mat-

ters, and he was admitted to practice before the U. S. Tax Court. Nevertheless, the Court held that he could not hold himself out to the public as a federal tax specialist.

We have established (supra, pp. 6-7) the right of each state to control the practice of law within its boundary. This right is based on the paramount interest of the state in protecting its citizens from improper and inadequate professional services. This interest extends to the preparation and prosecution of patent applications and applications for federal trademark registrations as much as to any other branch of the law. In the preparation and prosecution of such applications, many questions of state law arise. By way of example, an important question which arises when an inventor calls on a patent attorney for advice in the filing of an application is whether the inventor should file an application at all or should rely on the state law of trade secrets and confidential disclosure. A non-attorney who is unqualified to give advice on the state law not only provides an incomplete service but also may be rendering great disservice.

In the preliminary stage prior to filing an application, it is frequently necessary for a patent practitioner to advise his client as to his rights in the invention in view of an employer-employee relationship in which the client is involved. Does the employer or employee own the invention? If the client is a corporation, should an assignment be filed with the application? If the client is the employee, does the client have the right to file a patent application without the consent of his employer? In many instances, there is a written contract of employment and the patent practitioner must interpret this contract and give legal advice (clearly based on his

knowledge of state law) as to its effect before a decision can be reached on the filing of an application.

The idea submitted to the practitioner may be subject matter which properly is protected by a copyright rather than a patent, and the Commissioner of Patents has no way of testing the practitioner's knowledge of copyright law.

Further, the Patent Act of 1952 provides (35 U.S.C. 117):

> "Legal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor."

Thus a competent patent practitioner will need to know the laws of the state in which he is practicing to determine who is the legal representative of a deceased inventor whose invention he is processing and he should be able to determine whether, under the laws of the state, the inventor is under any legal incapacity.

Quite frequently, inventors wish to secure patents for their inventions not only in the United States but in foreign countries, and will naturally inquire of the practitioner to whom they take an invention whether or not they should or can file in foreign countries. The practitioner must have a working knowledge of foreign laws, and the giving of advice as to foreign law constitutes the practice of law in the state where the advice is given. *In re Roel* (1957) 3 N.Y. 2d 224, 144 N.E. 2d 24; appeal dismissed (1958) 355 U.S. 604.

Petitioner has admitted (R. 8) that he has "engaged in all phases of trademark practice before the

United States Patent Office." Such practice invariably involves the initial determination whether the client should file an application for a federal registration or whether his interests would best be protected by the filing of a state registration in view of provisions in state trademark statutes which are not provided in the federal trademark laws. As a third alternative the client might be better advised to rely on his "common law" trademark rights. Obviously, a knowledge of the trademark laws of the state (common law and statutory) is essential to decide these questions.

Petitioner has also admitted (R. 10) that he has prepared patent assignments. Assignments are contracts and the validity of contracts is determined primarily by state law.

Thus, the practice of patent and trademark law is the practice of a specialized branch of law requiring knowledge of both state and federal laws and a practice in which both the state and the federal government have legitimate interests. The federal government in the person of the Commissioner of Patents rightfully controls the operation of the Patent Office and regulates the recognition and conduct of persons representing applicants before the Patent Office in order that it may properly perform its functions. On the other hand, the State of Florida has a vital interest in the regulation of the practice of the law within the state of Florida. The citizens of Florida who seek advice in patent and trademark matters in Florida cannot be properly advised by one who does not have full knowledge of the laws of Florida. Therefore the Constitution of the United States has dele-

gated to Congress the administration of the Patent Office and has reserved exclusively to the states the power to authorize, regulate and control all phases of the practice of law in the states.

IV.

CONCLUSION

We submit that the decision of the Supreme Court of the State of Florida should be affirmed.

Respectfully submitted,

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